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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,761	07/22/2003	Danielle M. Wettling	81746JJH	6509

7590

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EXAMINER
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CHOI, FRANK I

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/624,761

Applicant(s)

WETTLING ET AL.

Examiner

Frank I. Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/22/2003</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement filed 7/22/2203 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. The parent case does not appear to contain FR 2,798,201 or the reference Chimie et Physique Photographiques (also, please provide publication year of said reference) (it is noted that said references are not listed on the front of the parent patent). As such, a copy of said references must be provided. It has been placed in the application file and considered except for the information referred to above. Further, Examiner notes that the title page on the IDS indicates that it is a supplemental IDS, however, there is no other IDS in the file.

### ***Drawings***

The drawings are objected to because of 37 CFR 1.84(u)(1) which indicates that where only a single view is used in an application to illustrate the claimed invention, it must not be numbered and the abbreviation "FIG. " must not appear. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

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consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities: As indicated above where there is only a single view the drawing should not be labeled with a figure number or the abbreviation "Fig.", as such, the Specification should only refer to the drawing as "The figure" without a number designation. Please update the reference to the related application by indicating that said application is now U.S. Patent No. 6,620,397. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101/112***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 provides for the use of the material according to claim 7, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process

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applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 13 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7-19 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 937 682.

EP 0 937 682 expressly discloses an aluminosilicate (imogolite) having grafted thereon an organic radical having a –SH or –S(CH<sub>2</sub>)<sub>n</sub>–S– group wherein n is from 0 to 4 in a photographic wash bath solution containing silver in ionic form and having dispersed in the aluminosilicate a biocide wherein the treated bath passes through a system of nanofiltration, an ion exchange resin or hydrotalcite (See claims 13, 17, 18, 19, Paragraphs 0036-0056).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application

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claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 7-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,179,898 or claims 1-5 of US Patent 6,440,308. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of said patent are directed to an aluminosilicate (imogolite) having grafted thereon an organic radical having a -SH or -S(CH<sub>2</sub>)<sub>n</sub>-S- group wherein n is from 0 to 4 in a photographic wash bath solution containing silver in ionic form and having dispersed in the aluminosilicate a biocide wherein the treated bath passes through a system of nanofiltration, an ion exchange resin or hydrotalcite.

Claims 7-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,361,699 in view of EP 0 937 682.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 2 of said patent are directed to an apparatus containing an aqueous solution which can contain silver ions and an imogolite including thiol groups which are capable of collecting silver ions present in the aqueous solution which is liable to develop microorganisms. Further, EP 0 937 682 is cited for the same reasons as above. The difference

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between the claimed invention and the claim of said patent is that the patent does not expressly disclose in said claim that the apparatus is a photographic wash bath or the use of a bacterial growth agent. However, the prior art amply suggests the same as the prior art discloses the use of imogolite in photographic wash baths containing silver ions and having biocides dispersed in said imogolite. As such, it would have been well within the skill of and one of ordinary skill in the art would have been motivated to modify the claims with the expectation that the claimed apparatus would be suitable as a photographic wash bath and would inhibit microbial growth in the aqueous solution.

Therefore, the claimed invention, as a whole, would have been an obvious modification of the claim of said patent to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of claim 2 of said patent and the cited reference.

Claims 7-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,555,008 in view of EP 0 937 682.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim of said patent are directed to an method of extracting metallic silver in an aqueous photographic silver halide developer by contacting with an imogolite having SH or  $-S(CH_2)_nS-$  groups wherein n is an integer from 1 to 4, where the developer circulates in a loop and the polymer is in a bag permeable to said developer. Further, EP 0 937 682 is cited for the same reasons as above. The difference between the claimed invention and the claims of said patent is that the patent does not expressly disclose in said claims the use of a bacterial growth

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agent. However, the prior art amply suggests the same as the prior art discloses the use of imogolite in photographic wash baths containing silver ions and having biocides dispersed in said imogolite. As such, it would have been well within the skill of and one of ordinary skill in the art would have been motivated to modify the claims with the expectation that biocides would be suitable for use in said method of extracting silver.

Therefore, the claimed invention, as a whole, would have been an obvious modification of the claim of said patent to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of claims 1-8 of said patent and the cited reference.

Claims 7-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5-9 of U.S. Patent No.6,361,699 in view of EP 0 937 682.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 5-9 of said patent are directed to a biocidal material containing biocides mixed in a gel containing a imogolite-type aluminosilicate and at least 50% by water and a device for delivering said biocide and method eliminating microorganisms with said biocide, including in photographic washing baths. Further, EP 0 937 682 is cited for the same reasons as above. The difference between the claimed invention and claims 5-9 of said patent is that the patent does not expressly disclose in said claims that a metal is present or that the imogolite has thiol groups. However, the prior art amply suggests the same as the prior art discloses the use of imogolite having thiol groups and having silver ions contained therein. As such, it would have been well within the skill of and one of ordinary skill in the art would have



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been motivated to modify the claims with the expectation that silver ions can be present in photographic wash baths and that imogolites having thiol groups would be suitable for incorporating said silver ions.

Therefore, the claimed invention, as a whole, would have been an obvious modification of the claim of said patent to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of claims 5-9 of said patent and the cited reference.

Examiner notes that the parent Application, issued as Patent No. 6,620,397 was subject to a restriction requirement.

### *Conclusion*

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is 571-273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (571)272-0610. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Gary Kunz, can be reached at 571-272-0887. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FIC

March 13, 2006



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**PATENT EXAMINER**  
**GROUP 1200**

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